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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,742	06/05/2000	Andrew S. Van Luchene	99-091	8655
22927	7590	09/28/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/586,742

Applicant(s)

VAN LUCHENE ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 109-136 is/are pending in the application.
- 4a) Of the above claim(s) 109-136 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 9/24/2004.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment received on 7/18/2005 is acknowledged and entered. Claims 95-108 are canceled in the current amendment resulting in cancellation of claims 1-108. New claims 109-136 have been added. Currently claims 109-136 are pending for examination.

### *Response to Arguments /Election/Restrictions*

2.1. Applicant argues, see Remarks, pages 9-10, that the earlier cited reference Ojha does not disclose the new claimed embodiments because they include the limitation that ***the controller determines if the desired product is unavailable***. Here, the examiner would like to invite the attention of the applicant to the election made by him in his amendment received on 10/31/2003 to the group "Invention I" including claims 1-59, 83-89 and 90-94 directed to a method and medium facilitating a transaction by matching offers from buyers and sellers.

Newly submitted claims 109-136 filed on 7/18/2005 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims 109-136 recite the limitation that ***the controller determines if the desired product is unavailable*** (see independent claims 109, 110 and Remarks, pages 9-10, which also confirm claiming the new embodiments claiming this limitation) which has a different utility than the earlier claimed inventions. The applicant has already elected an invention, as cited above, directed to a method and

Art Unit: 3625

medium facilitating a transaction by matching offers from buyers and sellers which does not require the utility/functionality to determine if the product is unavailable. Therefore the newly submitted amended claims are distinct from the earlier claimed inventions and would require a new and different search. Such change in the inventions amount to a "Shift claiming another invention after an election is once made and action given on the elected subject matter and are therefore subject to " Election by Original Presentation". as analyzed above.

It is further to be noted that the limitations of dependent claims 112-116 are directed to determination of an item price and a subsidy which were subject to restriction and election requirement and were not elected by the applicant, see Amendment received on 10/31/2003.

Kindly refer to the following MPEP excerpts for guidelines:

**819 Office Generally Does Not Permit Shift:**

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

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**821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

**821.03 Claims for Different Invention Added After an Office Action**

Claims added by amendment following action by the examiner, **MPEP § 818.01, § 818.02(a)**, to an invention other than previously claimed, should be treated as indicated by **37 CFR 1.145**.

**37 CFR 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143 and 1.144**

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The action should include form paragraph 8.04.

**¶ 8.04 Election by Original Presentation.....**

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An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

3. Therefore, newly submitted claims 109-136 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 109-136 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The amendment filed on 7/18/2005 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is **non-responsive** (MPEP § 821.03). The remaining claims, that is the new claims 109-136 are not readable on the elected invention because they are subject to "Election by Original Presentation". as analyzed above.

5. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

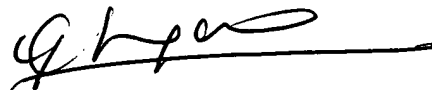
6. Examiner would also like to record his observation that he reviewed the applicant's disclosure and the original claims as filed on 6/5/2000 and could not find support for this limitation, that is ***the controller determines if the desired product is unavailable***. The original disclosure and the applicant's invention is directed to matching sellers' offers with the buyer's offer and not for checking if the product is available or not. The offers may not match in spite of the availability of material because the terms of sellers' offers may not match with the buyer's terms.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
September 24, 2005